

Allowable Subject Matter:

Applicant sincerely thanks the Examiner for indicating that claims 9, 12 and 13 have been allowed, and that claims 8 and 11, although objected to, would be allowable if written in independent form.

Claim Rejections:

Claims 1-16 are all of the claims pending in the present application, and currently claims 1-7, 10 and 14-16 stand rejected.

35 U.S.C. § 112, 1st Paragraph Rejection - Claims 1, 5 and 14:

Claims 1, 5 and 14 stand rejected under 35 U.S.C. § 112, 1st paragraph as containing subject matter not sufficiently described in the specification, so as to allow one of ordinary skill to recognize that the claimed invention was in possession of the inventors at the time the application was filed. Stated differently, the Examiner has rejected the claims as failing to satisfy the “written description” requirement of 35 U.S.C. § 112. In view of the following discussion, Applicant respectfully disagrees.

In rejecting the claims, the Examiner is simply stating that there is no disclosure in the application of having the first and second branches (11 and 12) “parallel” to each other. Because of this, the Examiner is ignoring this limitation in the claims, as well as rejecting these claims as set forth above. For the following reasons, Applicant disagrees with the Examiner.

Applicant notes that 35 U.S.C. § 112, 1st paragraph sets forth three distinct and separate requirements for a patent application. They are: (1) that the Applicant must disclose the “best mode” of making and using the invention known to the Applicant at the time the application is

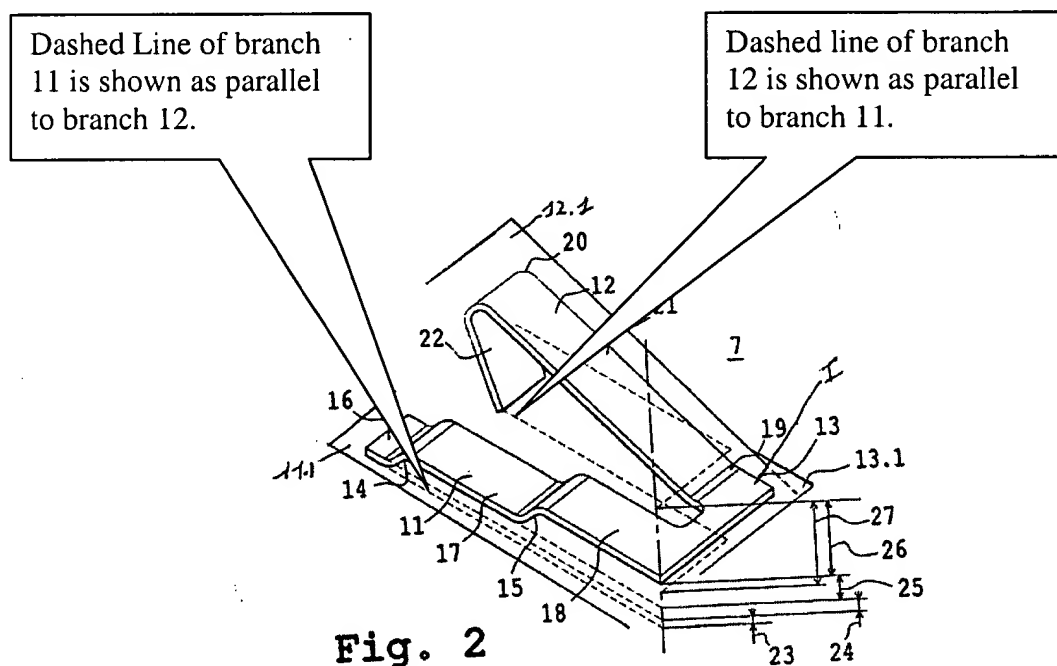
filed; (2) provide a “written description” of the claimed invention sufficient to show one of ordinary skill in the art that the Applicant was in possession of the invention at the time the application was filed; and (3) set forth sufficient information in the specification to enable one of ordinary skill in the art to make and use the claimed invention. *See* 35 U.S.C. § 112, 1st para.

“[T]he ‘essential goal’ of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed.” *In re Barker*, 559 F.2d 588, 592 n.4, (CCPA 1977). When determining whether or not this requirement has been met, the question is “does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.” *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989). In essence, the “written description” requirement requires that each and every element in the claims be adequately described in the specification to show one of ordinary skill in the art that the inventor was in possession of the invention at the time the application was filed. *See* MPEP § 2163.02. “[A]ll that is necessary to satisfy the description requirement is to show that one is ‘in possession’ of the invention.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991). “One shows that one is ‘in possession’ of the invention by describing the invention, with all of its claim limitations.” *Id.*

The Examiner has the initial burden of presenting evidence as to why such persons in the art would not recognize that Appellants “had” the invention at the time the application was filed. *See* MPEP § 2163(II)(A).

Applicant submits that when the present application is taken as a whole, including the Figures (which is well settled as part of the disclosure), the present application clearly shows that the inventors of the present application were in possession of the claimed invention, including that the first and second branches (11 and 12) “parallel” to each other.

Applicant first refers the Examiner to Figure 2 of the present application, reproduced below.



As shown in Figure 2, the branches 11 and 12 extend from the base 13 in a parallel fashion. This is clearly evidenced by the dashed lines which represent an outline of the branches 11 and 12. For example, it is clear that the dashed lines which extend from the “tip” of each of the branches 11 and 12 are parallel to each other, such that if they were extended they would not intersect.

Additionally, Figure 3, of the present application, also clearly shows that each of the branches 11/12 of the respective contacts are parallel to each other. As shown in Figure 3, the respective branches 11 and 12 are made parallel to each other.

Additionally, Applicant notes that the specification expressly states that “[t]he branch 12 is also mobile in a plane separate from but parallel to the plane in which the branch 11 moves.” Specification, page 7, lines 4-6 (emphasis added). One of ordinary skill in the art would easily recognize that if the branches 11 and 12 are mobile in planes which are “parallel” to each other, then the branches are positioned “parallel” to each other. Namely, when viewing the construction of the contact 7, as shown in Figure 2, Applicant submits that a skilled artisan would recognize that the inventors of the present application were in “possession” of having the branches 11 and 12 formed parallel to each other, as claimed. Particularly in light of the specification indicating that the branches 11, 12 are movable, relative to each other, in planes which are parallel to each other.

Secondly, the specification also makes it clear that “[t]he contacts are substantially parallel but the opposite way round relative to each other, a branch 11a of one contact 7a being adjacent a branch 12b of the adjacent contact 7b.” Specification, page 8, lines 22-26. This is clearly shown in both Figures 1 and 3 (reproduced below).

The branch 11 of the uppermost contact 7 is shown parallel to the branch 12 of the adjacent contact 7, and because the contacts 7 are parallel, as indicated in the application, then a skilled artisan would recognize that the respective branches 11 and 12 of a contact would need to be parallel.

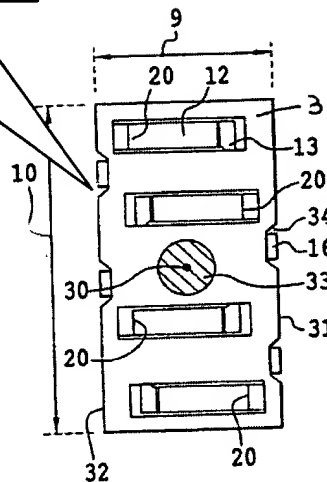


Fig. 3

In view of at least the foregoing disclosure and discussion, Applicant submits that one of ordinary skill in the art would recognize that the inventors of the present application were in possession of the claimed invention. Namely, the Figures and specification make it clear that the inventors were in possession of the branches 11 and 12 being made “parallel” to each other on a contact 7. The specification clearly indicates that the branches 11 and 12 are movable with respect to each other in adjacent parallel planes. (See discussion above). Because of at least this disclosure, and the Figures, a skilled artisan would recognize that the inventors were in possession of having the branches “parallel” to each other, as claimed.

In view of the foregoing, Applicant submits that a skilled artisan would recognize that the inventors of the present application were in possession of each and every feature of the claimed invention. Therefore, Applicant submits that the Examiner has failed to show that the claims of the present application fail to satisfy the “written description” requirement of 35 U.S.C. § 112. Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 112, 1st paragraph, rejection of the above claims.

Prior Art Rejections:

Applicant note that because of the above rejection, the Examiner has ignored the language of the claims which indicate that the branches are parallel to each other. As such, the Examiner continued to apply the previous prior art rejections (made in the November 7, 2003 Office Action).

However, in view of Applicant’s foregoing discussion, Applicant submits that the Examiner must properly consider all of the language of the claims, including the “parallel” limitation. Accordingly, Applicant incorporates herein all of Applicant’s previous arguments and discussions regarding the pending prior art rejections. For the same reasons as previously set forth, the prior art of record fails to disclose, teach or suggest each and every feature of the claimed invention.

Specifically, Applicant submits that the claims are allowable over the McKee reference, as the claims are now distinguished from an “L” shaped configuration.

Additionally, with regard to the Examiner’s assertions regarding “inherency” of the housing in McKee, Applicant respectfully disagrees. Applicant notes that “inherency” requires

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No.: 09/673,614

Our Ref.: Q61365
Art Unit: 2833

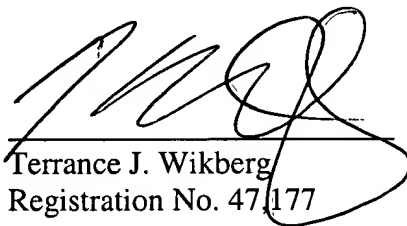
the claimed feature to be “necessarily present” in the disclosure. In fact, even if there were only two options in the reference (i.e. with or without a housing), this is insufficient to establish “inherency.” Thus, the Examiner’s rejection, in this regard, fails.

Conclusion:

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Terrance J. Wikberg
Registration No. 47,177

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: January 4, 2005